

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 3, 2010 has been entered.

Status of the Claims

2. This action is in response to the request for continued examination filed on March 3, 2010.

- Claims 1-51 are pending.
- Claims 1-35 have been cancelled.
- Claims 36, 40, 44 and 48 have been amended.

Response to Arguments

3. Applicant's arguments filed March 3, 2010 have been fully considered but they are not persuasive. Applicant argues on page 12 that prior art TD Canada Trust teaches way from Applicant's claimed invention and that Examiner has employed impermissible hindsight. Examiner disagrees. First, TD Canada Trust was brought in as a secondary reference to disclose "selecting with a computer the second part of the second security document; selecting with a computer the first part of the first security

document and combining with a computer the selected first part of the first security document and the selected second part of the second security document into an investor document (see Ref. U on top of page 3).” TD Canada Trust shows how an investor or user can select and download Part A and/or Part B of a mutual fund prospectus while online using a computer. Automating this manual activity would have been obvious to one skilled in the art. Levering discloses a method and system to create personalized investor information packages, based on investor information, to be delivered to the investor to satisfy both compliance regulations and investor preferences. Levering further discloses in paragraph 65 and Figure 5:

[0065] As illustrated in FIG. 5, the prior art system of sending a full product book of compliance information to a user is replaced by the present system of dividing the full product book into compliance information for several products. That specific compliance information may be arranged as individual documents by CUSIP number. They are then matched with individual investors' account holdings. Those product holders are then sent an appropriate book which combines only the relevant information for that particular user.

Levering teaches the general concept of reducing a full product book (prospective- Part A and Part B) into an “appropriate book” which combines only the relevant information for the investor (Part A and individual documents of Part B). Levering further teaches in paragraphs 65-67, to send the investor only “relevant information” based on investors account holdings (see paragraphs 65-66). In addition, Levering teaches in paragraph 50 to determine what past documents have already been sent to the investor so duplicate mailings are avoided.

4. Applicant argues on page 12 that TD Canada Trust does not disclose a first security document and a second security document. Applicant further points to Money Market Funds on page 3 of TD Canada Trust that may contain information on more than one fund. Examiner disagrees. Money Market Funds may be referring to a family of

funds, however one skilled in the art would know that Money Market Funds (Part B) reads on a second security document (see page 2, under the heading Prospectus) and Part "A" reads on a first security document.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 36-51 rejected under 35 U.S.C. 103(a) as being unpatentable over Levering et al., U.S. Patent Application Publication 2005/0125316 (see PTO-892, Ref. D) in view of website www.tdcanadatrust.com (hereinafter TD Canada Trust) as evidenced by TD Mutual Funds Download Centre (see PTO-892, Ref. U).

7. As per claim 36, Levering teaches a computer implemented method for use in connection with a transaction with a security, which method comprises the steps of:

storing at least a first and second security documents on a document storage database of a computer, wherein each security document describes a security, and wherein each security document comprises of a plurality of parts, wherein each part of the plurality of parts is associated with an identifier (see paragraph 48);

receiving a first transaction record with information regarding an ownership of at least one security by an investor from a computer, wherein the first transaction record

comprises of a plurality of parts wherein each of the plurality of parts contains information related to ownership of the at least one security by the investor (see paragraphs 50, 54 and 65);

mapping with a computer at least one part of the plurality of parts of the first transaction record to at least a first identifier (see paragraphs 50 and 54-55);

determining with a computer from past security documents sent to the investor, if any, whether the investor did not previously receive at least a first part of the at least one security document from the document storage database wherein the first part is associated with the first identifier (see paragraph 50);

receiving a second transaction record with information regarding an ownership of at least one security by the investor from a computer, wherein the second transaction record comprises of a plurality of parts wherein each of the plurality of parts contains information related to ownership of the at least one security by the investor (see paragraphs 50, 54 and 65);

mapping with a computer at least one part of the plurality of parts of the second transaction record to at least a second identifier (see paragraphs 50 and 54-55);

determining with a computer from past security documents sent to the investor, if any, whether the investor did not previously receive at least a second part of the second security document from the document storage database wherein the second part is associated with the second identifier (see paragraph 50);

delivering the investor document to the investor (see abstract).

Levering does not explicitly teach selecting with a computer the second part of

the second security document; selecting with a computer the first part of the first security document and combining with a computer the selected first part of the first security document and the selected second part of the second security document into an investor document. Levering does teach if it has been determined from the past security documents sent to the investors (see paragraph 50).

TD Canada Trust teaches selecting with a computer the second part of the second security document from the document storage database; selecting with a computer the first part of the first security document and combining with a computer the selected first part of the first security document and the selected second part of the second security document into an investor document (see Ref. U on top of page 3). TD Canada Trust shows how an investor or user can easily select and download Part A and/or Part B of a mutual fund prospectus. It is understood by one skilled in the art that prospectus information at TD Canada Trust website is stored in a document storage database.

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Levering and TD Canada Trust to modify Levering's invention to combine two parts of a prospectus because it would reduce the cost of delivering the information to the investor as taught by Levering (see paragraph 7).

8. As per claim 37, Levering and TD Canada Trust teach the method of claim 36 as described above. Levering further teaches wherein the security document is a

prospectus and wherein the identifier is a security identifier or a trade identifier (see paragraph 4).

9. As per claim 38, Levering and TD Canada Trust teach the method of claim 36 as described above. Levering further teaches wherein the first security document and the second security document are from different issuers (see paragraph 4).

10. As per claim 39, Levering and TD Canada Trust teach the method of claim 36 as described above. TD Canada Trust teaches wherein the investor document further comprising of at least one part of the first transaction record and at least one part of the second transaction record (see Ref. U on top of page 3).

Therefore, it would be prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Levering and TD Canada Trust to modify Levering's invention to combine two parts of a prospectus comprising a first transaction and a second transaction because it would reduce the cost of delivering the information to the investor as taught by Levering (see paragraph 7).

11. Claim 40 recites similar limitations to claim 36 and thus rejected using the same art and rationale in the rejection of claim 36 as set forth above.

12. Claim 41 recites similar limitations to claim 37 and thus rejected using the same art and rationale in the rejection of claim 37 as set forth above.

13. Claim 42 recites similar limitations to claim 38 and thus rejected using the same art and rationale in the rejection of claim 38 as set forth above.

14. Claim 43 recites similar limitations to claim 39 and thus rejected using the same art and rationale in the rejection of claim 39 as set forth above.

15. Claim 44 recites similar limitations to claim 36 and thus rejected using the same art and rationale in the rejection of claim 36 as set forth above.
16. Claim 45 recites similar limitations to claim 37 and thus rejected using the same art and rationale in the rejection of claim 37 as set forth above.
17. Claim 46 recites similar limitations to claim 38 and thus rejected using the same art and rationale in the rejection of claim 38 as set forth above.
18. Claim 47 recites similar limitations to claim 39 and thus rejected using the same art and rationale in the rejection of claim 39 as set forth above.
19. Claim 48 recites similar limitations to claim 36 and thus rejected using the same art and rationale in the rejection of claim 36 as set forth above.
20. Claim 49 recites similar limitations to claim 37 and thus rejected using the same art and rationale in the rejection of claim 37 as set forth above.
21. Claim 50 recites similar limitations to claim 38 and thus rejected using the same art and rationale in the rejection of claim 38 as set forth above.
22. Claim 51 recites similar limitations to claim 39 and thus rejected using the same art and rationale in the rejection of claim 39 as set forth above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHAHID R. MERCHANT whose telephone number is (571)270-1360. The examiner can normally be reached on First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shahid R Merchant/
Examiner, Art Unit 3694